

USSN 10/772,944
Group Art Unit: 3762
Docket No. 151P08970US02

REMARKS

Claims 1 – 23 are pending in this application.

This application is a continuation of U.S.S.N. 09/596,566, Kast et al, filed June 19, 2000, and, as filed, contained claims essentially identical to the claims pending in U.S.S.N 09/596,556 on the filing date of this application. U.S.S.N. 09/596,566 was under FINAL rejection on the filing date of this application and had received an Advisory Action mailed November 26, 2003 ("Advisory Action"). This Preliminary Amendment is responsive to the Advisory Action.

Amendments to the Claims

Claims 1, 22 and 23 have been amended for clarity to make it clear that the recharging coil is not doubly recited. No new matter has been added.

Claim 23 has also been amended to positively recite mating of at least one attachment detail with the at least one housing alignment detail. Support for this amendment can be found in the specification, e.g., on page 9 at lines 4 – 18. No new matter has been added.

Claims 1 – 22

In the prior application (U.S.S.N. 09/596,566), claims 1 – 22 had been rejected over Leysieffer. In the Advisory Action, the Examiner states:

Leysieffer is read as teaching the recharging coil being substantially carried on the proximal face (figures 3 and 6), where the implanted device is oriented such that the recharging coil is on the proximal face of the device, the proximal face being the side of the device closest to the skin to enable energy transfer.

Both independent claims (claims 1 and 22), however specifically require more. For example, claim 1 requires "a recharging coil centrally located and substantially carried on the housing proximal face and electrically coupled through the housing electrical feedthrough to the electronics and rechargeable power source." Similarly,

USSN 10/772,944
 Group Art Unit: 3762
 Docket No. 151P08970US02

claim 22 requires "means for attaching the means for recharging coil to a position centrally located and substantially carried on the housing proximal face."

Such a centrally located position is not shown, described or contemplated by Leysieffer. Figure 3 of Leysieffer shows "receiving coil 106" positioned completely off to one side of "main module housing 72'."

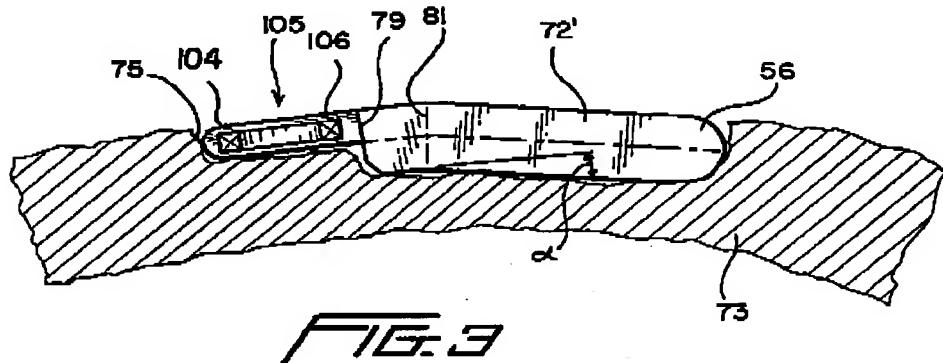
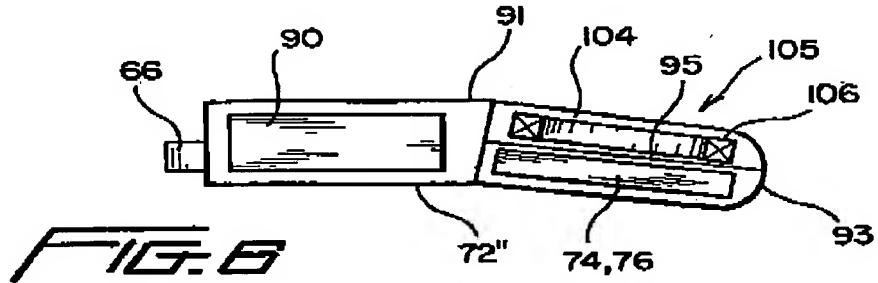


Figure 6 of Leysieffer shows "receiving coil 106" and "battery 90" positioned side-by-side, again putting "receiving coil 106" completely off to side of the implantable medical device.



There is nothing in Leysieffer to show or suggest the centrally located feature of the presently claimed invention. Further, Leysieffer does not achieve the significant advantageous benefit realized by the central location.

USSN 10/772,944
Group Art Unit 3762
Docket No. 151P08970US02

The Examiner notes that "the specification supports, on page 2, lines 15-17, 'non-central locations' for the recharging coil such as a 'remote location from the medical device'." While true, the fact that the specification supports multiple embodiments has no affect whatsoever on the patentability of the currently pending claims. As I am sure that the Examiner is aware, the Applicant is entitled to claim whatever the Applicant regards as the invention as long as that embodiment is supported by the specification, as it clearly is here. Further, embodiment of the invention cited by the Examiner (located remotely from the medical device) is clearly identified in the summary of the invention as being an alternative embodiment not a requirement for all embodiments of the invention (see page 2, lines 16 – 18: "In another embodiment, the recharging coil can either be ... located remotely from the medical device.").

In order to support a *prima facie* case of obviousness, the Examiner must present art which clearly shows the centrally located feature (along with all other requirements of the claims and, if those features are located in multiple references, a motivation to combine the features). This the Examiner has not done. Thus, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

It is important that the primary charging coil be aligned with the receiving coil to achieve optimum charging efficiency, to prevent time consuming delays in charging and to possibly prevent undesirable temperature increases as a result of the charging process. Centrally locating the receiving coil in the present invention allows the patient and/or clinician to physically align the primary charging coil with the receiving coil by physically aligning the primary coil with the physical protrusion of the implanted medical device. If the receiving coil is not centrally located on the implanted medical device, this is impossible. Because the location of the receiving coil can not be determined during charging in Leysieffer, the charging of receiving coil is inefficient and time consuming.

Thus, it is respectfully submitted that independent claims 1 and 22 are not obvious in view of Leysieffer and should be allowable.

Dependent claims 2 – 21 should also be allowable for the same reasoning.

USSN 10/772,944
Group Art Unit 3762
Docket No. 151P08970US02

Claim 23

In the prior application (U.S.S.N. 09/596,566), claim 23 had also been rejected primarily over Leysieffer. In the Advisory Action, the Examiner states:

"it is noted that the features upon which the Applicant relies (i.e., the alignment details having "geometries to accomplish their purpose such as latches, barbs, polymer anchors and the like") are not recited in the rejected claim(s)."

Independent claim 23, however specifically requires a "housing having at least one housing alignment detail" and a "recharging coil having at least one attachment detail mating with the at least one housing alignment detail." Leysieffer vaguely says:

"It goes without saying that all lines shown in simplified form in the figures, depending on the components which connect them, can be made in principle with one or several poles. The corresponding applies to the coupling elements and the line penetrations through the housing or parts." (Column 4, lines 14 – 19);

It is respectfully submitted that the language of Leysieffer referring to "in principle ... one or several poles" does not disclose, show nor suggest the language specifically required in the claim as having at least one attachment detail mating with at least one housing alignment detail.

The details of alignment details and attachment details described in the specification as having 'geometries to accomplish their purpose such as latches, barbs, polymer anchors and the like' (page 5, lines 11 – 13) are only examples of housing alignment details and housing attachment details are not required to be specifically identified in the claims absent a reference disclosing a housing alignment detail and a housing attachment detail, and all of the other claimed features, which Leysieffer does not.

Without a clear showing that Leysieffer shows a housing attachment detail mating with a housing alignment detail, which it does not, claim 23 should be allowable over Leysieffer and should be allowable.

USSN 10/772,944
Group Art Unit: 3762
Docket No. 151P08970US02

Summary

In view of the amendments made and the arguments presented, claims 1 - 23 should be allowable, this application should be in condition for allowance and a notice to that is earnestly solicited.

Respectfully Submitted,

JOHN E. KAST ET AL.

August 18, 2004



William D. Bauer
Registration No. 28,052

IPLM Group, P.A.
Broadway Place West, Suite 6600
1300 Godward Street NE
Minneapolis, Minnesota 55413-1741
Telephone: 612-331-7405
Facsimile: 612-331-7401